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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/603,674	06/25/2003	William J. Barz	1001-021C2	3813

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EXAMINER

GUTMAN, HILARY L

ART UNIT PAPER NUMBER

3612

DATE MAILED: 06/25/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 10/603,674	Applicant(s) BARZ ET AL.	
	Examiner Hilary Gutman	Art Unit 3612	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 25 May 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 22-44 is/are pending in the application.
- 4a) Of the above claim(s) 25-28, 31, 35-38 and 41 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 22-24, 29, 30, 32-34, 39, 40 and 42-44 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>1/15/04</u> . | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Election/Restrictions*

1. Applicant's election of Species A in the reply filed on 5/25/04 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

2. Claims 25-28, 31, 35-38, and 41 are hereby withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 5/25/04.

### *Information Disclosure Statement*

3. The information disclosure statement filed 1/15/04 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each U.S. and foreign patent; each publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. It has been placed in the application file, but the information referred to therein has not been considered.

### *Claim Objections*

4. Claims 29-30, 39-40, and 44 are objected to because of the following informalities:

In claims 30, 40, and 44, line 2, "material" should be inserted after "foam".

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In claims 29 and 39, on line 2, "said" should perhaps be inserted before "ribs" (first occurrence). Appropriate correction is required.

### ***Double Patenting***

5. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

6. Claims 42, 43, and 44 are objected to under 37 CFR 1.75 as being substantial duplicates of claims 33, 34, and 40, respectively. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

### ***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant

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for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claims 22, 29, 32, and 39 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over JP 10-53156.

JP '156 discloses a reinforced pillar system (Figure 5) for an automotive vehicle, comprising: an automotive vehicle frame 1, 2 for a pillar of the automotive vehicle, the frame having a plurality of wall portions defining a cavity 6a, 6b therein; a skeleton member 10 disposed within the cavity, the skeleton member having a longitudinal axis, the skeleton member comprising a first upper portion with a plurality of ribs 11 12 and a second lower portion extending away from the first portion, the second portion also including a plurality of ribs 11, 12; and a structural foam material 21 in sealing contact with the skeleton member and at least one of the plurality of wall portions, wherein; at least two of the plurality of ribs 11, 11 of the first portion are in spaced apart opposing relation to each other.

For claim 32, JP '156 discloses a reinforced pillar system for an automotive vehicle, comprising: an automotive vehicle frame 1, 2 for a pillar (Figure 5) of the automotive vehicle, the frame having a plurality of wall portions defining a cavity 6 therein; a skeleton member 10 disposed within the cavity, the skeleton member 10 having a longitudinal axis, the skeleton member comprising a first upper portion with a plurality of ribs 11, 12 and a second lower portion extending away from the first portion, the second portion also including a plurality of ribs 11, 12; and a structural foam material 21 in sealing contact with the skeleton member and at least one of the plurality of wall portions, wherein; at least one of the plurality of ribs 11 of the first portion and at least

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two of the plurality of ribs 11, 11 of the second portion are in spaced apart opposing relation to each other; and the first portion is contiguous with the second portion and the first portion and the second portion are substantially aligned with each other along the longitudinal axis.

With regard to claims 29 and 39, at least two ribs 11, 12 in the first portion intersect with each other and the plurality of ribs in the first portion are substantially devoid of the foam.

Although JP '156 fails to disclose the structural member within a "roof" and pillar system, it should be noted that pillars are well known in the prior art to be connected at a top portion via a roof (as seen in Figure 5). Furthermore, structural members of this type with foam thereon are capable of placement in the roof and pillar area of vehicle as evidenced by Takagi. It is apparent that the structural member of JP '156 is "capable" of placement in the roof and pillar area of a vehicle to satisfy the "for a roof and pillar" limitation of the claim.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have provided the structural member of JP '156 within a roof and pillar system (as taught by Takagi) in order to strengthen the roof and pillar area of the vehicle.

9. Claims 22 and 32 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over JP 10-71628.

JP '628 discloses a reinforced pillar system for an automotive vehicle, comprising: an automotive vehicle frame 1 for a pillar of the automotive vehicle, the frame having a plurality of wall portions (Figure 4) defining a cavity therein; a skeleton

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member 10 disposed within the cavity, the skeleton member having a longitudinal axis, the skeleton member comprising a first (upper) portion with a plurality of ribs 12a, 12a and a second (lower) portion extending away from the first portion, the second portion also including a plurality of ribs; and a structural foam material 21 in sealing contact with the skeleton member and at least one of the plurality of wall portions, wherein; at least two of the plurality of ribs of the first portion are in spaced apart opposing relation to each other.

For claim 32, JP '628 discloses a reinforced pillar system for an automotive vehicle, comprising: an automotive vehicle frame 1 for a pillar of the automotive vehicle, the frame having a plurality of wall portions (Figure 4) defining a cavity therein; a skeleton member 10 disposed within the cavity, the skeleton member having a longitudinal axis, the skeleton member comprising a first (upper) portion with a plurality of ribs 12a, 12a and a second (lower) portion extending away from the first portion, the second portion also including a plurality of ribs (not numbered, seen in Figure 5); and a structural foam material 21 in sealing contact with the skeleton member and at least one of the plurality of wall portions, wherein; at least one of the plurality of ribs of the first portion and at least two of the plurality of ribs of the second portion are in spaced apart opposing relation to each other; and the first portion is contiguous with the second portion and the first portion and the second portion are substantially aligned with each other along the longitudinal axis.

Although JP '628 fails to disclose the structural member within a "roof" and pillar system, it should be noted that pillars are well known in the prior art to be connected at a top portion via a roof. It is believed that pillar 1 of JP '628 would act in a similar

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manner. Furthermore, structural members of this type with foam thereon are capable of placement in the roof and pillar area of vehicle as evidenced by Takagi. It is apparent that the structural member of JP '628 is "capable" of placement in the roof and pillar area of a vehicle to satisfy the "for a roof and pillar" limitation of the claim.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have provided the structural member of JP '628 within a roof and pillar system (as taught by Takagi) in order to strengthen the roof and pillar area of the vehicle.

10. Claims 22 and 32 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Wycech.

Wycech (6,058,673) discloses a reinforced system for an automotive vehicle, comprising: an automotive vehicle frame 22 for a rail of the automotive vehicle, the frame having a plurality of wall portions (Figure 4) defining a cavity 24 therein; a skeleton member 36" disposed within the cavity, the skeleton member having a longitudinal axis, the skeleton member comprising a first portion (or lower portion) with a plurality of ribs (not numbered) and a second portion (or upper portion) extending away from the first portion, the second portion also including a plurality of ribs 38, 38; and a structural foam material 48, 50 in sealing contact with the skeleton member and at least one of the plurality of wall portions, wherein; at least two of the plurality of ribs of the first portion are in spaced apart opposing relation to each other.

For claim 32, Wycech discloses a reinforced system for an automotive vehicle, comprising: an automotive vehicle frame 22 for a rail of the automotive vehicle, the



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frame having a plurality of wall portions (Figure 4) defining a cavity 24 therein; a skeleton member disposed within the cavity, the skeleton member having a longitudinal axis, the skeleton member comprising a first portion (lower portion) with a plurality of ribs (not numbered) and a second portion (upper portion) extending away from the first portion, the second portion also including a plurality of opposed ribs 38, 38 (extending from each side of web 42); and a structural foam material 48, 50 in sealing contact with the skeleton member and at least one of the plurality of wall portions, wherein; at least one of the plurality of ribs (generally 40) of the first (lower) portion and at least two of the plurality of ribs (38, 38) of the second portion are in spaced apart opposing relation to each other (wherein each of ribs 38, 38, are vertically spaced from rib 40); and the first portion is contiguous with the second portion and the first portion and the second portion are substantially aligned with each other along the longitudinal axis.

Although Wycech fails to disclose the structural member within a roof and pillar system, it should be noted structural members of this type with foam thereon are capable of placement in the roof and pillar area of vehicle as evidenced by Takagi. Furthermore, it is apparent that the structural member of Wycech is “capable” of placement in the roof and pillar area of a vehicle to satisfy the “for a roof and pillar” limitation of the claim.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have provided the structural member of Wycech within a roof and pillar system (as taught by Takagi) in order to strengthen the roof and pillar area of the vehicle.

***Claim Rejections - 35 USC § 103***

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

13. Claims 23-24, 30, 33-34, 40, and 42-44 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP '156, as modified, and as applied to claims 22 and 32 above, and further in view of Takahara (6,267,436)

For claims 23, 33, and 42, JP '156, as modified, teaches a roof rail adjoining an A-pillar and the skeleton member entirely within the A-pillar (Figure 5).

JP '156, as modified, lacks the first portion of the skeleton member being located in the roof rail and the second portion of the skeleton member extending into the A-pillar.

<sup>2436</sup>  
Takahara teaches an impact energy absorbing structure for use in a roof and pillar system (best seen in Figure 19). The energy absorbing structure spans the area of a roof rail and an A-pillar and extends from the roof rail through to the A-pillar. In addition, the

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energy absorbing structure in one form (Figure 9) can apparently include first and second portions with ribs 82 and 84.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have provided the first portion of the skeleton member of JP '156, as modified, within the roof rail (whereby the second portion of the skeleton member extends into the A-pillar) as taught by Takahara<sup>1</sup> in order to provide additional reinforcement and strengthening support for this area of the vehicle.

With regard to claims 24, 34, and 43, the first portion has a first cross-sectional area taken generally perpendicular to the axis that is less than about 50 percent of second cross-sectional area of the second portion taken generally perpendicular to the axis, such as through ribs 12.

With regard to claims 30, 40, and 44, the skeleton member and the structural foam cooperatively seal the cavity to block passage (Figure 7B) of materials through the cavity.

### *Conclusion*

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hilary Gutman whose telephone number is 703-305-0496.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenn Dayoan can be reached on 703-308-3102. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

**16. Any response to this action should be mailed to:**

Assistant Commissioner for Patents


Washington, D.C. 20231

**or faxed to:**

(703) 872-9326, (for formal communications intended for entry)

**or:**

(703) 746-3515, (for informal or draft communications, please clearly label "PROPOSED" or "DRAFT").

 6/21/04  
D. GLENN DAYOAN  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3600